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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,946	04/16/2001	Isao Hirose	Q63660	5342

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EXAMINER

NGUYEN, JIMMY T

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,946

Applicant(s)

HIROSE ET AL.

Examiner

Jimmy T Nguyen

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3725

DETAILED ACTION

Response to Amendment

The amendment filed on November 26, 2002 under 37 CFR 1.131 has been considered and an action on the merits follows.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, means for heating (claim 2), means for vibrating (claim 3), a band heater (claim 11), and an air cylinder (claim 12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Line 11, the claim amended by adding the type of releasing the layer by curling it with the release member, the specification (from page 7 and thereafter, as mentioned in applicant's remarks) does not clearly show the specific type of curling process beside the releasing process.

Art Unit: 3725

Further, it is inherent that the layer is curl/peel off the roll when the layer is being released by the release member.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not support "a band heater", the specification only discloses an electric heater (page 10, line 21).

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3, 5, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Masayuki et al. (JP363158156A). See discussion in previous Office action and the discussion under 35 U.S.C. 112, first paragraph above regarding the new amended limitation "by curling it".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masayuki et al. Masayuki. See discussion in previous Office action.

Art Unit: 3725

Claims 2, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masayuki, in view of Borgstrom (USPN 6,325,878). See discussion in previous Office action. With regard to a band heater (claim 11), it would have been an obvious matter of design choice to have the band heater as the heating means, since applicant has not disclosed that the band heater solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with Borgstrom's heating means.

Claims 4, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masayuki et al., in view of Gerhardt (USPN 5,601,868). See discussion in previous Office action. With regard to a specific type of vibrating means (claim 12), the use of an air cylinder is an obvious matter of design choice. However, note that Masayuki also discloses means for vibrating (15) such as an air cylinder, so that the tip of the doctor knife is apart from the outer surface of the rolls (3, 4) (see page 2, right col., last four lines to page 3, left col., lines 1-2).

Response to Arguments

Applicant's arguments filed November 26, 2002 have been fully considered but they are not persuasive.

Applicant argues that the Masayuki reference does not show "a release member is disposed behind a nip portion of a center roll". The release element (14) is, in fact "behind" the holding roller (4). Note that the center roller (page 5, line 8) is not claimed. Further, the argument that Masayuki is disposed "at the nip portion" (page 5, line 10) is not found persuasive because the knife would simply jam (at the nip portion) if it operated as interpreted by applicant.

Art Unit: 3725

Applicant does not clearly define the term "behind" the nip portion. If the release member is only a millimeter away from the center of the nip portion, it is considered that the release member is behind the nip portion. Figure 1 clearly shows the doctor knife (14) in contact with a holding roll (4) near a nip portion between roll (4) and roll (12). Therefore, it is inherent that the release member is arranged in contact with the holding roll (4) "behind" the nip portion, and it is inherent that the plastic material sheet layer is curl/peel off the roll when the being release by the release member.

With regard to claims 2 and 6, applicant argues that Borgstrom neither describes nor suggests the use of scraping doctor knife to improve surface smoothness of a plastic material sheet, and the specific meaning and effect of heating. However, the argument is not found persuasive because it relates to subject matter that is not in the claims.

With regard to claims 4 and 8, applicant argues that Gerhardt neither describes nor suggests the use of vibrating doctor knife to improve surface smoothness of a plastic material sheet. However, the argument is not found persuasive because it relates to subject matter that is not in the claims. Note that Masayuki also discloses a similar type of vibrating blade by using air cylinder as discussed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 3725


MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy T Nguyen whose telephone number is (703) 305-5304. The examiner can normally be reached on Mon-Thur 8:00am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on (703) 308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

JTNguyen
January 28, 2003


ALLEN OSTRAGER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700